## REMARKS

Reconsideration of this application is respectfully requested. Claims 1-8 and 14-34 are pending in this application. Claims 1-3, 14 and 34 stand rejected. Claims 4-8 and 15-33 were withdrawn from consideration as being directed to a non-elected invention.

### Claim Rejections – 35 U.S.C. §103

Claims 1, 14 and 34 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Yano et al.** (USP 6,701,732, previously cited). For the reason set forth in detail below, this rejection is respectfully traversed.

Initially, it is noted that the previous rejection over **Yano et al.** has been changed from a §102 rejection to a §103 rejection. The current rejection over **Yano et al.** is a §103 rejection because the Office Action now recognizes that **Yano et al.** do not disclose the claimed "storage means for storing said real-time encoded data...". However, the Examiner asserts that the "storage means" would have been obvious to one of ordinary skill in the art. See page 2, Item 6 of the Office Action.

*The Examiner has not established a prima facie case of obviousness*

It is respectfully submitted that a *prima facie* case of obviousness under §103 has not been established, and therefore the rejection is improper and should be withdrawn.

The Office Action recognizes that **Yano et al.** do not disclose the claimed "storage means". The Examiner asserts that "it would have been obvious to one of ordinary skill in the art

that writing data between unit would require storage to preserve the data, for further processing." See page 2, Item 6 of the Office Action. However, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, a single prior art reference (**Yano et al.**) that completely lacks the claimed "storage means" has been applied against the claims, and, despite the absence of the teaching of the claimed storage means, the Office Action concludes that it would have been obvious to modify that reference to include the claimed "storage means" because "writing data between unit ***would require storage*** to preserve the data, for further processing" [emphasis added].

First, it is respectfully submitted that the lack of disclosure or suggestion of a "storage means" by **Yano et al.** negates the stated motivation for modifying **Yano et al.** because the **Yano et al.** reference does **not** include the claimed storage means, and therefore does **not** require the claimed storage means.

Second, it is well established that although the structure in a prior art reference ***could*** be modified to form the claimed structure, "the mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Laskowski*, 871 F. 2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989). Further, although a prior art device "may be ***capable*** of being modified to run the way

[the patent applicant's] apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990).

It is respectfully submitted that the **Yano et al.** reference provides no motivation or suggestion to modify the **Yano et al.** reference in the manner suggested by the Office Action. Specifically, as noted in the Amendment under 37 C.F.R. §1.114 filed on March 20, 2006, the **Yano et al.** reference is directed to a system that transmits burst data ***directly to a network***, temporarily occupying a network band, with the result that packet collision and packet loss tend to occur and transmission efficiency deteriorates. **Yano et al.** simply does not suggest a "storage means" as claimed.

Further, **Yano et al.** teaches controlling transmission on the basis of unarrived data volume between two end terminals on a network (i.e., network buffer data volume), and does not suggest or even hint use of a buffer (i.e., storage means) to control transmission to the network.

Thus, it is respectfully submitted that the **Yano et al.** reference provides no suggestion or motivation to modify the reference as suggested by the Examiner, as required under §103. Thus, a prima facie case of obviousness has not been established and the rejection under §103 is improper for at least this reason.

*The Yano et al. reference does not disclose all claimed elements*

It is respectfully submitted that **Yano et al.** does not disclose or suggest the claimed "transmission timing control and transmission means ...wherein packets corresponding to respective frames are transmitted sequentially to the network during a period between when said

encoder ends writing real-time encoded data corresponding to a frame to the storage means and when said encoder begins writing real-time encoded data corresponding to a next frame to the storage means...", as recited in claim 1 (and similarly in claim 14).

The Examiner cites column 3, line 57 – column 4, line 3 and column 13, lines 38-48 to teach the above-noted claimed features. In particular, the Examiner specifically relies on the statement "Upon completion of transmission of data, data generation (step 201), and transmission (step 202) repeat themselves." See col. 3, lines 65-67 of **Yano et al.** Based on this statement from **Yano et al.** the Examiner concludes "therefore the encoded data is not written until after the transmission is completed, and the encoding of data takes place in the data generation step,..." (see last four lines in Item 5 of Office Action).

First, the Examiner has admitted that **Yano et al.** do not disclose the claimed "storage means". Therefore, **Yano et al.** cannot disclose the claimed timing of transmitting packets to the network ***with respect to writing of encoded data to a storage means***. In other words, if there is no storage means disclosed, it follows that there can be no disclosure related to timing of writing data to a non-disclosed element (i.e., the storage means).

Second, the passages cited by the Examiner to support the rejection (i.e., col. 3, line 57 – col. 4, line 3 and col. 13, lines 38-48) actually provide support for the fact that **Yano et al.** does not disclose, suggest or render obvious a "storage means" as claimed. For example, col. 13, lines 38-48 describes that after the video data generator 1001-11 captures the video data, the video data is compressed, packetized and passed to data transmitter 1001-12 which transmits the data.

Thus, **Yano et al.** teaches that the video data is sent from the video data generator 1001-11 directly to the data transmitter 1001-12 with no storage in between.

Further, with respect to claim 34, **Yano et al.** do not disclose or suggest the claimed "transmission timing control and transmission means ... wherein the transmission timing and control means controls transmission of packets corresponding to respective frames to the network ***based on a determination of a time during which the encoder writes frame data to the storage means*** and ***a determination of a time between frames***, ..."

**Yano et al.** do not disclose or suggest that the transmission timing to the network is based on determinations of (1) a time during which the encoder writes frame data to the storage means, and (2) a determination of a time between frames. **Yano et al.** simply do not disclose or suggest making the claimed determinations and using these two determinations to control transmission timing to the network. Further, the Examiner has not pointed out where the **Yano et al.** reference discloses making these determinations and controlling transmission timing to a network based on these determinations.

Accordingly, it is submitted that claim 34 distinguishes over the **Yano et al.** reference for these additional reasons.

**Claim Rejections – 35 U.S.C. §103**

Claims 2 and 3 were rejected under 35 U.S.C. §103 as being unpatentable over **Yano et al.** in view of **Boyce** (USP 6,490,705, previously cited).

Claims 2 and 3, which depend from claim 1, patentably distinguish over the combination of **Yano et al.** and **Boyce** for the same reasons as claim 1 by virtue of their dependency thereon.

## CONCLUSION

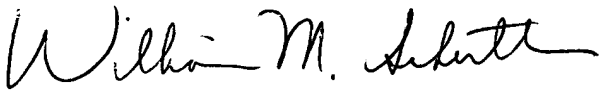
In view of the foregoing amendments and accompanying remarks, it is submitted that all pending claims are in condition for allowance. A prompt and favorable reconsideration of the rejection and an indication of allowability of all pending claims are earnestly solicited.

If the Examiner believes that there are issues remaining to be resolved in this application, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite and complete prosecution of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

**WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP**



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